

Application No. 10/009,147
Applicants: Peter Himmelsbach et al.
Amendment in Response to Office Action dated February 26, 2004

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

In view of the amendments above, Applicant believes that the application is in immediate condition for allowance, and, therefore, no stringent showing under 37 CFR § 1.116(b) is required.

Claims 2-14 and 16-28 are pending. Claim 15 has been canceled, and claim 28 is the main claim. Claims previously dependent on claim 15 have been amended to depend on claim 28. Changes that have been made to the claims are presented above using strikethrough and underlining. It is believed that no new matter has been added.

Rejections under 35 U.S.C. 112, second paragraph

The Examiner rejected the claims as being indefinite under 35 U.S.C. 112, second paragraph. The Examiner found the term "combination" to be indefinite. In response, Applicants have amended the claim to recite "medical article" as suggested by the Examiner. Applicants note that because the term "medical article" is in the preamble, there is respectfully no difference between a "medical article" and an "article", and therefore, believe the term "medical article" is not a limitation. The Examiner also found claim 14 did not contain antecedent basis for the term "substrate". Antecedent basis is now provided in claim 14.

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In view of the amendments above and the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Rejections under 35 U.S.C. 103

The Examiner rejected claims 2-28 under 35 U.S.C. 103(a) as being obvious over EP 0885942A1 as combined with statements made at page 2, 4th paragraph of the instant specification, each taken individually or in view of statements made at page 1, 2nd paragraph of the instant specification, and for substantially the same reasons made in the Office Action dated July 10, 2003. The Examiner also found the thermoplastic rubber-type copolymer component in EP 0885942A1 to be the same block copolymer utilized in the above-identified application. Ultimately, the Examiner concluded that:

"..the performance parameters claimed by applicants would be either inherent, since the compositions appear to be made from essentially the same composition as applicants disclose, or be but a minor modification thereof."

In response, as to the alleged admissions, Applicants respectfully submit that no such admission was made, and, if the Examiner disagrees, Applicants respectfully requests that the Examiner point to page and line number where such admissions are seen.

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Referring to EP 0885942A1, Applicants submit there is no motivation in the reference that would have led a person skilled in the art to the instantly claimed invention, because there is nothing to suggest a medical article which comprises "individual plies or turns of the medical article adhere to other plies or turns of the medical article, but not substantially to a substrate selected from the group consisting of skin, hair and clothing". EP 0885942A1 at page 2, lines 36-39 explicitly refers to articles having hotmelt formulations for securing the articles "for a period of time when attached to a surface such as fabric or skin without causing skin irritation." Moreover, Tables 1 and 2 in the EP reference discloses data for an article having an adhesive applied thereon relating to "peel adhesion" to steel, textile and skin.

The Examiner indicates that the instantly claimed invention is a "minor modification thereof" of what is taught in EP 0885942A1. However, Applicants submit that the instantly claimed invention is fundamentally different. That is, the good adhesion to skin touted by the reference conflicts with the properties required by the instant invention, wherein the inventive product sticks to itself but exhibits substantially no adhesion to skin, hair and clothes as evidenced by clause (iv) in claim 28. Claim 28 further characterizes this property in relating clause (iv) to clause (iii), wherein the cold seal composition comprises a " $\tan \delta$ of less than 0.4 at a temperature of 25°C and a frequency of 100 rad/s". Applicants point out $\tan \delta$ is reflected as a measurement of "product properties such as tack and shear stability", wherein "a low numerical value denotes low tack and good shear stability". See instant specification at page 6, line 21 to page 7, line 5. Due in part to the instantly claimed $\tan \delta$ values, the inventive product

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adheres to itself, but shows substantially no adhesion to skin, hair and clothes. Therefore, Applicants submit there is nothing in the reference which teaches or suggests this property, which is demonstrated in the instant specification. It is worth repeating the mere fact that references can be combined or modified, which Applicants do not concede here, does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicants refer the Examiner to Example 1 in the instant specification, wherein a bond strength of 0.6 N/cm of the medical article to itself was measured, and no sticking to the skin was observed. Examples 2 through 5 similarly comprise measured bond strength values. Nowhere in EP 0885942A1, either alone or combination, is there any motivation for the article to have a bond strength to itself, but also substantially no bond strength to skin. Accordingly, Applicants submit the claims are not rendered obvious by the cited reference, either alone or in combination.

As to the Examiner's position that the claimed parameters are inherently present, if the Examiner rely on a theory of inherency as to any particular element, Applicants point out the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the reference, and the presence of such element therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Applicants submit the Examiner has not discharged this burden. The properties required by the instant invention cannot be considered inherent in the cited prior art, as EP 0885942A1 expressly teaches that the article described therein has different properties.

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In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Conclusion


Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.